

REMARKS

Claims 1-9 and 13-60 are pending in this application. In the official action dated July 27, 1995, claims 1-9, 13-34 and 37-60 were rejected, and claims 35 and 36 were objected to. More particularly, the drawings and specification were objected to, and claims 1-9 and 13-31 were rejected under 35 U.S.C. Section 112, first paragraph, because the specification and drawings allegedly do not disclose or illustrate the "restraint" limitation recited in the claims. Claims 7-9, 13-21, 33, 34 and 37-60 were rejected under 35 U.S.C. Section 112, second paragraph, for allegedly failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 32-34, 37-39, 41, 42, 44, 45 and 52 were rejected under 35 U.S.C. Section 102(b) as allegedly anticipated by Lemelson. Claims 40 and 53-60 were rejected under 35 U.S.C. Section 103 as allegedly obvious in view of Lemelson. It was also noted in the office action that Claims 35 and 36 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten to in independent form including all of the limitations of the base claim and any intervening claims. Also, claims 1-9 and 13-31 would be allowable if rewritten or amended to overcome the rejection under 35 U.S.C. Section 112. Finally, a new oath/declaration identifying the pending application by serial number and filing date was required.

Applicants filed a response to the outstanding office action on November 27, 1995 in an attempt to address the rejections and objections and place the application in condition for allowance. On January 3, 1996, the Examiner issued an Advisory Action indicating that the proposed claims amendments in the November response had overcome all but the 35 U.S.C. Section 112 first paragraph rejection of claims 1-9 and 13-31.

The present response incorporates the amendments and arguments that were directed to the prior art rejections and the 35 U.S.C. 112 second paragraph rejections, and also attempts to again address the 35 U.S.C. Section 112 first paragraph issues raised in the outstanding office action.

Regarding the 35 U.S.C. Section 112 first paragraph issues, Applicants submit that an example of the claimed "restraint" is illustrated and disclosed by the inner surface of a first lumen 24 formed inside the catheter 21. The bent needle 22 is positioned inside the first lumen 24 such that the catheter 21 acts as a restraint holding the bent needle 22 in a retracted position. As best illustrated in Figures 2 and 3, the first lumen 24 formed inside the catheter 21 holds the puncturing element in its retracted position until the restraining force provided by the catheter surface is removed by moving the puncturing element toward the "window" opening 30 in the catheter 21. When the restraining force of the lumen 24 is no longer being applied, the needle 22 is free to move automatically to its puncturing position.

The specification has been amended to more clearly describe that a restraint is used to hold the puncturing element in its retracted position, and also that the restraining force may be provided by the inner wall of the catheter lumen that houses the relevant portion of the puncturing element. Thus, there is now a clear correspondence between the claim language and the supporting disclosure in the specification and claims. These amendments amplify and name elements and operations that were disclosed and illustrated in the original application as filed, and therefore the amendments do not involve new matter or any other objectionable change.

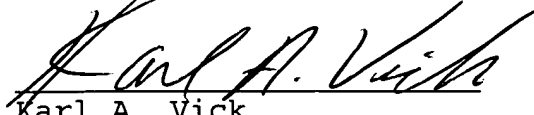
Certain claim amendments that were submitted in the November 27, 1995 response have been made again here to the appropriate ones of claims 7-9, 13-21, 33, 34 and 37-60 to address their rejection under 35 U.S.C. Section 112, second paragraph.

Claims 32 and 42 have been amended to each incorporate the substance of claim 35 (which was noted as being allowable), thus defining claims 32-34, 37-42, 44, 45 and 52-60 over the Section 102(b) and 103 rejections based on Lemelson.

Finally, Applicants submitted on November 27, 1995 a new oath/declaration identifying the pending application by serial number and filing date.

Accordingly, it is respectfully submitted that the accompanying amendments and remarks respond fully to the outstanding office action and place the claims in condition for allowance. If, for any reason, the Examiner is unable allow the application on the next office action and feels that a telephone conference would help clear up any unresolved matters, the Examiner is respectfully requested to contact the undersigned attorney at the telephone number listed below.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Karl A. Vick", is written over a horizontal line.

Karl A. Vick

Registration No. 33,288

Attorney for Applicant

WILLIAN BRINKS HOFER
GILSON & LIONE
P.O. BOX 10395
CHICAGO, ILLINOIS 60610
(312) 321-4247